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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,149	09/10/2003	Christopher J. Nagel	27151.2001-US3	4820

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EXAMINER

KOPEC, MARK T

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,149

Applicant(s)

NAGEL, CHRISTOPHER J.

Examiner

Mark Kopec

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 7/14/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is responsive to applicant's response filed 7/14/05. Claims 1-13 are pending.

The amendment to the specification is entered.

The IDS filed 8/8/05 has been considered. An initialed copy accompanies this Office Action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-1 of U.S. Patent No. 6,572,792.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/659,090, claims 1-5 of copending Application No. 10/690,391, and the allowed claims of 10/123,028.

These rejections are maintained for the reasons set forth in the Rejection mailed 4/21/05 (pages 3-4).

Applicant's remarks regarding these rejections are noted.

The examiner respectfully maintains that the instant claims do not merely overlap in scope with the above listed patents and applications, but fully encompass/dominate such materials. See MPEP 804.

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Claims 1-13 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These rejections are maintained for the reasons set forth in the Rejection mailed 4/21/05 (pages 4-11).

Applicant's remarks regarding these rejections are noted.

After careful consideration of the evidence as a whole, the examiner respectfully maintains that the theory set forth in the specification as to the transformations which occur in the claimed materials, together with the statements to the effect that invention relates to a new composition of matter comprised of 'p', 'd', and/or 'f' atomic orbitals, are insufficient to prove that the disclosed process produced the alleged results ("characterized by a calibrated Uniquant analysis report wherein the report recites the presence of an element in the periodic table wherein said composition has not been in contact with said element"). While the disclosed examples do appear to display compositions characterized by a calibrated Uniquant analysis report wherein the report recites the presence of an element in

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the periodic table wherein said composition has not been in contact with said element (in several of the Figures/Tables), the examiner respectfully submits that the data produced may disclose the presence of initially undetected defect elements present during sample preparation or heating schedule, or inadvertently present during preparation for analysis.

The examiner respectfully maintains that according to contemporary knowledge of physics and chemistry, and according to all generally accepted theories of atomic structure, that the processes disclosed throughout the instant specification cannot alter the underlying atomic structure of a composition to arrive at the presence of elements different from the starting composition ("characterized by a calibrated Uniquant analysis report wherein the report recites the presence of an element in the periodic table wherein said composition has not been in contact with said element"). The examiner does acknowledge, as evidence by the issued parent applications, that the disclosed processes result in patentable differences as compared to prior art compositions. However, the examiner respectfully maintains that such patentable difference are not due to "new elements" resulting from change in atomic orbitals, but changes that may be explained as the result of atomic interactions which may be

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described and predicted by the current and well-explored theories regarding the behavior of materials.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention.

These rejections are maintained for the reasons set forth in the Rejection mailed 4/21/05 (pages 11).

Applicant's remarks regarding these rejections are noted.

The examiner acknowledges that the claimed "Uniquant analysis report" is a trademark software program for use with sequential X-ray fluorescence. Applicant is suggested to amend the claims to recite --characterized by an X-ray fluorescence analysis report wherein the report recites the presence of an element in the periodic table wherein said composition has not been in contact with said element--.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Kopec
Primary Examiner
Art Unit 1751

MK

October 15, 2005